

Filed by: APJ Adriene Lepiane Hanlon
Box Interference
Washington, D.C. 20231
Tel: 703-308-9896
Fax: 703-308-7953

The opinion in support of the decision being entered today is not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

JEFFREY L. TALLON, ROBERT G. BUCKLEY and MURAY R. PRESLAND,
Junior Party,¹

v.

CHING-WU CHU,
Junior Party,²

v.

KOUICHI KUGIMIYA, SEIJI ADACHI, OSAMU INOUE
and SYUNICHIRO KAWASHIMA,
Junior Party,³

v.

¹Application 07/335,819, filed April 10, 1989. Accorded the benefit of New Zealand Application 224,205, filed April 8, 1988. Assigned to Her Majesty the Queen in Right of New Zealand.

²Application 07/163,956, filed March 3, 1988. Assigned to the University of Houston, Houston, Texas.

³Application 07/550,795, filed July 9, 1990. Accorded the benefit of U.S. Application 07/306,305, filed February 3, 1989, and Japanese Applications 63-26128, filed February 5, 1988, 63-26129, filed February 5, 1988, and 63-26130, filed February 5, 1988. Assigned to Matsushita Electric Industrial Co., Ltd., Osaka, Japan.

Interference No. 102,462

HANS-GEORG VON SCHNERING, WILFRIED BECKER,
MARTIN SCHWARZ, BERNHARD HETTICH,
MARTIN HARTWEG, LEONHARD WALZ and THOMAS POPP,
Junior Party,⁴

v.

JAGANNATHA GOPALAKRISHNAN, ARTHUR W. SLEIGHT
and MUNIRPALLAM A. SUBRAMANIAN,
Junior Party,⁵

v.

HIROSHI MAEDA, YOSHIAKI TANAKA,
MASAO FUKUTOMI and TOSHIHISA ASANO,
Senior Party.⁶

Patent Interference No. 102,462

FINAL HEARING: April 27, 1999

Before CAROFF, PATE and HANLON, Administrative Patent Judges.

HANLON, Administrative Patent Judge.

DECISION ON RECONSIDERATION

⁴Application 07/525,547, filed May 18, 1990. Accorded the benefit of U.S. Application 07/305,854, filed February 2, 1989, and German Application P3803530.8, filed February 5, 1988.

⁵Application 07/528,270, filed May 24, 1990. Accorded the benefit of U.S. Applications 07/153,107, filed February 8, 1988, and 07/152,186, filed February 4, 1988. Assigned to E.I. du Pont de Nemours and Co., Wilmington, Delaware.

⁶Application 07/293,465, filed January 4, 1989. Accorded the benefit of Japanese Application 10084/1988, filed January 20, 1988. Assigned to National Research Institute for Metals, Tokyo, Japan.

Interference No. 102,462

This is a response to a Request for Reconsideration of a final decision, mailed March 29, 2001, in the above-identified interference. The request was filed by senior party Maeda et al. (Maeda). Paper No. 384. Junior party Tallon et al. (Tallon) filed an opposition to Maeda's request. Paper No. 388. For the reasons set forth below, Maeda's request for reconsideration is granted-in-part.

Background

A party seeking reconsideration of a final decision rendered by the Board pursuant to 37 CFR § 1.658(a) must "specify with particularity the points believed to have been misapprehended or overlooked [by the Board] in rendering the decision." 37 CFR § 1.658(b) (2000).

In its request for reconsideration, Maeda requests that this panel reconsider the following points:

(1) The Maeda motion to deny Tallon the benefit of the filing date of the first-filed Tallon New Zealand application.⁷ See Paper No. 384, pp. 2-6.

(2) The dismissal of the "Notice under 37 CFR §§ 1.642/1.655." See Paper No. 384, pp. 6-8.

⁷New Zealand application no. 224,205, filed April 8, 1988.

Interference No. 102,462

(3) The granting of Tallon's motion to suppress certain evidence introduced by Maeda. See Paper No. 384, pp. 8-12.

(4) This panel's failure to consider the Maeda ME-1 and Maeda M-B articles in its review at final hearing of the APJ's denial of Maeda's motion for judgment under 37 CFR § 1.633(a) on the ground that Tallon's claims 117-119 and 121 are unpatentable to Tallon under 35 U.S.C. §§ 102(a)/103. See Paper No. 384, pp. 12-15.

(5) The affirmance of the APJ's decision to deny Maeda's motion for judgment under 37 CFR § 1.633(a) on the ground that Tallon's claims 117-119 and 121 are unpatentable to Tallon under 35 U.S.C. §§ 102(a)/103. See Paper No. 384, pp. 16-20.

Point (1)

Maeda's motion to deny Tallon benefit of its first-filed New Zealand application may directly impact this panel's decision affirming the APJ's denial of Maeda's motion under 37 CFR § 1.633(a) for judgment on the ground that Tallon's claims 117-119 and 121 are not patentable to Tallon under 35 U.S.C. §§ 102(a)/103 and/or 102(f)/103. Therefore, this panel will consider Maeda's motion to deny Tallon benefit of its first-filed New Zealand application (Paper No. 265) and accompanying motion under 37 CFR § 1.645(b) (Paper No. 264).

Interference No. 102,462

In its motion under 37 CFR § 1.645(b), Maeda argues that the facts upon which Maeda's motion to deny benefit are based were not known to Maeda prior to Dr. Tallon's deposition on January 20th and 21st of 1994. According to Maeda, that testimony revealed, for the first time in this interference, that Tallon's first-filed New Zealand priority application fails to comply with the requirements of 35 U.S.C. § 112, first paragraph as (1) not providing an enabling disclosure and (2) failing to disclose the best mode known to Tallon at the time the New Zealand application was filed. See Paper No. 264, pp. 2-3. Specifically, Maeda argues that Dr. Tallon's testimony revealed that (1) a minimum amount of time of reaction is "critical" to produce the product of the Tallon invention, (2) a step-wise reaction procedure was used to produce the Tallon product, and (3) a specific separation technique was used to isolate the high Tc product from a mixed phase sample. See Paper No. 264, pp. 3-5.

Tallon argues that Maeda had access to the above-identified "facts" prior to the close of the preliminary motion period. Tallon points to a September 6, 1991, affidavit of Dr. Tallon,⁸ a

⁸Referred to hereinafter as the "first Tallon affidavit."

Interference No. 102,462

November 8, 1991, affidavit of Dr. Tallon,⁹ and a Nature article attached to the second Tallon affidavit. Therefore, as to enablement, this panel agrees with Tallon that Maeda failed to show good cause why the motion to deny benefit was not filed earlier. See Magdo v. Kooi, 699 F.2d 1325, 1329-31, 216 USPQ 1033, 1037-38 (Fed. Cir. 1983) (challenge to enablement, which was raised after motion period had ended, was clearly tardy, since basis for asserted attack could have been determined from a simple reading of the patent); see also Maier v. Hanawa, 26 USPQ2d 1606, 1610 (Comm'r Pats. 1992) (if information which could have been discovered with reasonable effort within the period set by the EIC, its later discovery after the expiration of the period would not be sufficient cause for delay for the late filing of any preliminary motion relying on that information).

However, as for best mode, this panel finds that Maeda has shown good cause why the motion to deny benefit was not filed earlier. Significantly, the best mode requirement of 35 U.S.C. § 112, first paragraph, relates to what an inventor regarded as the best mode of carrying out his/her invention at the time an

⁹Referred to hereinafter as the "second Tallon affidavit."

Interference No. 102,462

application was filed. See Standard Oil Co. v. American Cyanamid Co., 774 F.2d 448, 452, 227 USPQ 293, 296 (Fed. Cir. 1985) (the first paragraph of 35 U.S.C. § 112 requires that the inventor adequately disclose the best mode contemplated by the inventor, at the time of filing, in carrying out the invention). Maeda correctly points out that Dr. Tallon's affidavits are silent as to the date the laboratory work described therein was performed. Indeed, it is Dr. Tallon's deposition testimony which reveals for the first time on this record that the laboratory work was performed prior to the filing date of Tallon's first New Zealand application. Therefore, this panel will consider Maeda's motion to deny benefit as it relates to the best mode requirement of 35 U.S.C. § 112, first paragraph.

As the movant, Maeda bears the burden of establishing, by a preponderance of the evidence, that Tallon is not entitled to the filing date of its first New Zealand application. See Kubota v. Shibuya, 999 F.2d 517, 520-21, 27 USPQ2d 1418, 1420-21 (Fed. Cir. 1993) (a party filing a preliminary motion, including a motion attacking the benefit accorded another party under 37 CFR § 1.633(g), bears the burden of proof as to the requested relief); Bruning v. Hirose, 161 F.3d 681, 686, 48 USPQ2d 1934, 1938 (Fed. Cir. 1998) (validity challenges between copending

Interference No. 102,462

applications invoke the preponderance of the evidence standard). Specifically, Maeda must show that the best mode for carrying out the invention of Tallon's claims 117-119 and 121 was not disclosed in Tallon's first-filed New Zealand application. For the reasons set forth below, Maeda has failed to satisfy that burden.

According to 35 U.S.C. § 112, first paragraph, a specification "shall set forth the best mode contemplated by the inventor of carrying out his invention." As explained by the Court in United States Gypsum Co. v. National Gypsum Co., 74 F.3d 1209, 1212, 37 USPQ2d 1388, 1390 (Fed. Cir. 1996):

Determining whether a patent complies with the best mode requirement involves two underlying factual inquiries. First, it must be determined whether, at the time the patent application was filed, the inventor had a best mode of practicing the claimed invention. . . . This inquiry is wholly subjective and addresses whether the inventor must disclose any facts in addition to those sufficient for enablement. . . . Second, if the inventor had a best mode of practicing the claimed invention, it must be determined whether the specification adequately disclosed what the inventor contemplated as the best mode so that those having ordinary skill in the art could practice it. . . . The latter question "is largely an objective inquiry that depends upon the scope of the claimed invention and the level of skill in the art." [Citations omitted.]

See also Clayton v. Akiba, 214 USPQ 374, 380-81 (Bd. Pat. Int. 1982) (where an invention is drawn to a novel compound, its

Interference No. 102,462

preparation is part and parcel of "carrying out his invention" within the meaning of 35 U.S.C. § 112, first paragraph).

First, Maeda argues that pages 103 and 104 of the Tallon deposition transcript reveal that "time of heating" was an important factor in the production of the invention of Tallon's claims 117-119 and 121 (Paper No. 265, pp. 10-11):

At TD-103 Dr. Tallon was asked: "Did you explore differences in the amount of time that was used?" He answered: "We did some exploration of that and we found that short reactions -- and the reason we were looking at short reactions is that that had been a focus of our previous work in 123 -- we found that short reactions were inadequate to produce significant quantities of the higher T_c phase". [Emphasis added.]

From this testimony, Maeda concludes that "Tallon knew but failed to disclose the best mode relative to time of reaction known to them when they filed the New Zealand application." See Paper No. 265, p. 11.

The testimony relied on by Maeda is not persuasive. See De George v. Bernier, 768 F.2d 1318, 1325, 226 USPQ 758, 763 (Fed. Cir. 1985) (in order to find that the best mode requirement is not satisfied, it must be shown that the applicant knew of and concealed a better mode than he disclosed). To the extent that time of reaction is a factor in producing the high T_c phase, this testimony fails to establish that Tallon considered time of

Interference No. 102,462

reaction to be part of the best mode of carrying out the invention of claims 117-119 and 121 at the time the first New Zealand application was filed. See Wahl Instruments, Inc. v. Acvious, Inc., 950 F.2d 1575, 1581, 21 USPQ2d 1123, 1128 (Fed. Cir. 1991) (any process of manufacture requires the selection of specific steps and materials over others; the best mode does not necessarily cover each of these selections). Furthermore, where one of ordinary skill in the art would know how to select a specific operating condition (e.g., time of reaction) so as to achieve a particular result (e.g., "significant" quantities of the high T_c phase), the failure to include a recitation of that specific condition in the specification does not give rise to a violation of the "best mode" requirement of 35 U.S.C. § 112.¹⁰ In re Karnofsky, 390 F.2d 994, 997, 156 USPQ 682, 685 (CCPA 1968).

Next, relying on paragraph 6 of the first Tallon affidavit and pages 101 and 102 of the Tallon deposition transcript, Maeda

¹⁰In its motion to deny Tallon benefit of its first-filed New Zealand application, Maeda argues that the disclosure of the first-filed New Zealand application is not enabling because it fails to disclose a time of reaction for producing the invention of Tallon's claims 117-119 and 121. However, for the reasons set forth above, that issue was not timely raised, and thus, is not properly before this panel.

Interference No. 102,462

argues that this testimony establishes that Dr. Tallon knew, at the time the first New Zealand application was filed, that a "stage-wise" reaction was important in producing the invention of Tallon's claims 117-119 and 121. See Paper No. 265, pp. 11-12.

The testimony relied on by Maeda fails to establish that Dr. Tallon contemplated any step-wise reaction, particularly the step-wise reaction described in paragraph 6 of the first Tallon affidavit, to be part of the best mode of carrying out the invention of Tallon's claims 117-119 and 121. Compare paragraph 6 of the first Tallon affidavit with page 104 of the Tallon deposition transcript ("the reaction for a period of ten hours at 850 and ten hours at 860 was sufficient to produce a significant fraction [of the high Tc compound]" (emphasis added)).

Furthermore, based on the evidence of record, it appears that one of ordinary skill in the art would have recognized, at the time Tallon's first New Zealand application was filed, that a step-wise reaction was an effective way to produce a homogeneous sample. See the articles describing step-wise reactions at Tabs, H, I, J, K and L attached to Tallon's opposition to Maeda's motion to deny benefit. As pointed out above, where one of ordinary skill in the art would know how to select a particular

Interference No. 102,462

operating condition so as to achieve a particular result, the failure to include a recitation of that specific condition in the specification does not give rise to a violation of the best mode requirement of 35 U.S.C. § 112. Karnofsky, 390 F.2d at 997, 156 USPQ at 685.

Significantly, the "final all important reaction" referred to by Tallon on page 101 of his deposition transcript is disclosed in the first-filed New Zealand application. Compare page 228 of the Tallon deposition transcript (preparation of samples with significant amounts of bulk 2223 requires reaction in a relatively narrow band of temperatures around 860°C up to 865°C) with the first-filed New Zealand application (2223 phase produced by "off-stoichiometry partial-melt reaction of Bi_2O_3 , SrCO_3 , CaCO_3 and CuO in the ratio of $\frac{1}{2}:1:1:3$ at 860°C followed by a rapid quench to room temperature").

Finally, relying on pages 105 and 106 of the Tallon deposition transcript, Maeda argues that Tallon's failure to disclose magnetic levitation as a method of separating the 2223 phase from the 2212 phase was a violation of the best mode requirement. Tallon testified as follows (Tallon deposition transcript, pp. 105-106):

A what we explicitly saw was two distinct phases, 2212, 2223, distinct grains of each.

Q Did you treat that product in such a way as to separate those phases?

A Yes. We did. In the first instance, in the first round of characterization, we carried out studies in the electron microscope and, of course, in the electron microscope, with a ground sample, you can visually separate individual particles that are there without physically separating, and these were the first studies that we did.

And at the end of February, it was apparent that we had two distinct chemical compounds here. And that work is described here.

In addition, as I've also described under questioning, we separated the phases by magnetic levitation in liquid oxygen with a lower temperature phase, had a lower Tc than the 90 Kelvin, and the higher Tc phase had a transition of 105 Kelvin and this enabled the physical separation of the particles.

Tallon argues that magnetic levitation was not part of the process used to produce "bulk 2223," but rather, was a technique employed to facilitate identification of the material after it had been produced. See Tallon deposition transcript, p. 279 ("The levitation process was simply directed towards characterizing the materials.").

Regardless of whether magnetic levitation was necessary to "produce" the invention of Tallon's claims 117-119 and 121, the testimony relied on by Maeda fails to establish that Tallon considered magnetic levitation to be part of the best mode of carrying out the invention of Tallon's claims 117-119 and 121.

Interference No. 102,462

The testimony relied on by Maeda merely discusses the use of two different methods, magnetic levitation and visual separation, to separate the 2223 and 2212 phases.

For the reasons set forth above, Maeda's motion under 37 CFR § 1.645(b) is granted-in-part. As to enablement, Maeda's motion to deny Tallon benefit of its first-filed New Zealand application is dismissed, and as to best mode, Maeda's motion to deny Tallon benefit of its first-filed New Zealand application is denied.¹¹

Points (3) and (4)

Maeda requests that this panel reconsider its decision granting Tallon's motion to suppress certain evidence introduced by Maeda, specifically, an Endo article, a Nobumasa article, and two Nikkei Superconductors publications. See final decision, p. 8.

¹¹In its reply, Maeda argues that Tallon's opposition to Maeda's motion to deny benefit and von Schnering's response to the motion violate 37 CFR § 1.618(b) and requests that the papers be returned. Inasmuch as Maeda failed to satisfy its initial burden, this panel declines to consider whether these papers were filed in violation of 37 CFR § 1.618. Additionally, Maeda argues that the declaration of Dr. Tallon dated March 4, 1994, filed with Tallon's opposition to Maeda's motion to deny benefit, should not be considered until Maeda is provided an opportunity to cross-examine Dr. Tallon with respect to the statements set forth therein. This panel did not consider any statements made by Dr. Tallon in his declaration of March 4, 1994, in its review of Maeda's motion to deny Tallon benefit. Therefore, this issue is moot.

Interference No. 102,462

In its final decision, the Board explained (final decision, p. 8):

To the extent that Maeda relied on these articles and publications at final hearing to establish that Tallon's claims 117-119 and 121 are unpatentable under 35 U.S.C. §§ 102 and/or 103, they are not the subject of a motion under 37 CFR § 1.633 or a belated motion. See 37 CFR § 1.655(b). Therefore, Tallon's motion to suppress is granted.¹⁴

¹⁴According to Maeda in its brief at final hearing, APJ Ronald H. Smith indicated that evidence relied on by Maeda to establish that the Nikkei Superconductors publications are "proper publications" would be considered at final hearing. See MB, p. 34. In view of the basis for granting Tallon's motion to suppress, it is not necessary to consider this evidence.

Maeda does not dispute that these articles and publications were not the subject of a preliminary motion(s) under 37 CFR § 1.633 or a belated motion but rather argues that the references were properly introduced under 37 CFR § 1.682, and therefore, should have been considered by this panel at final hearing. Maeda's argument is without merit.

As correctly pointed out by Tallon in its opposition, 37 CFR § 1.682 merely sets forth the requirements for introducing evidence into the record and does NOT dispense with the need to file preliminary motions. See Patent Interference Proceedings, 49 Fed. Reg. 48416, 48428 (Dec. 12, 1984) ("Section 1.682 sets

Interference No. 102,462

out how a party may introduce in evidence, if otherwise admissible, official records or printed publications.").

Therefore, even assuming that the above-identified articles and publications were properly introduced under 37 CFR § 1.682, the fact remains that Maeda failed to (1) raise the issue of whether Tallon's claims 117-119 and 121 are unpatentable under 35 U.S.C. § 102/103 over the Endo article, the Nobumasa article and/or the two Nikkei Superconductors publications in a motion under 37 CFR § 1.633 or (2) show good cause why that issue was not raised in a timely filed motion.¹² See 37 CFR § 1.655(b).

Likewise, Maeda would have this panel consider the Maeda ME-1 and Maeda M-B articles in its review of the APJ's denial of Maeda's motion for judgment under 37 CFR § 1.633(a). See Request for Reconsideration, pp. 12-15; final decision, pp. 8-13. As for the Maeda ME-1 article, there is no dispute that Maeda failed to

¹²In its request for reconsideration, Maeda argues that the "Maeda Reply to the Objection of Party Tallon et al. to the Admissibility of Documents Designated in the Maeda Notice of Evidence Relied Upon" is "tantamount to a late motion because the content of this paper contained all that was required in a late motion including the reasons why the documents were important." See Request, p. 11. The panel's attention is directed to pages 21 through 23 of the reply. Manifestly, a reply is NOT a motion. Nevertheless, Maeda's explanation that "if Maeda was aware of the references or citations in the JLTL Nature article, the Nikkei publications might have been uncovered earlier" (emphasis added) is a far cry from a showing of good cause.

Interference No. 102,462

raise the issue of whether Tallon's claims 117-119 and 121 are unpatentable over the Maeda ME-1 article in a motion for judgment under 37 CFR § 1.633(a) or a belated motion that was granted. See 37 CFR § 1.655(b). Rather, Maeda argues that Tallon was aware of the existence of the article during the course of the interference.¹³ Clearly, such "notice" is not a substitute for a properly filed motion.

As for the Maeda M-B article, Maeda argues that the Maeda M-B article was properly relied on in its reply to Tallon's opposition to Maeda's motion for judgment under 37 CFR § 1.633(a) to respond to arguments made by Tallon relating to inherency and "therefore was added to bolster Maeda's patentability argument." See Request for Reconsideration, p. 13. This panel maintains otherwise. See Final decision, p. 10 (to the extent that Maeda relied on the Maeda M-B article in its reply to establish inherency, the issue was not timely raised).

However, even assuming that the Maeda M-B article was properly relied on by Maeda in its reply, this panel additionally

¹³In its final decision, this panel recognized that Tallon relied on the Maeda ME-1 article in its opposition to Maeda's motion for judgment under 37 CFR § 1.633(a). However, the panel further noted that Maeda did not address the article in its reply. See Final Decision, p. 9, n.16.

Interference No. 102,462

found that Maeda failed to establish prima facie that the article is prior art to Tallon under 35 U.S.C. § 102(a). See Final Decision, pp. 10-12. In its request for reconsideration, Maeda did not cite any authority which requires this panel to modify its decision. See Kubota v. Shibuya, 999 F.2d at 520-21, 27 USPQ2d at 1420-21 (a party filing a preliminary motion bears the burden of proof with respect to the requested relief); Behr v. Talbott, 27 USPQ2d 1401, 1405 (Bd. Pat. App. & Int. 1992) (with respect to all motions brought under the new interference rules (37 CFR 1.601 et seq.), the moving party bears the burden of making out a prima facie case of entitlement to the relief sought). Maeda merely "disagreed" with this panel's decision and apparently combed the record "ex post facto" for evidence in an attempt to establish that the Maeda M-B article is prior art to Tallon under 35 U.S.C. § 102(a). See Request for Reconsideration, pp. 14-15.

A mere disagreement with the panel's decision is not a proper matter for reconsideration under 37 CFR § 1.658. Furthermore, the portions of the record which Maeda now relies on in its request for reconsideration were not relied on in its motion for judgment under 37 CFR § 1.633(a), or for that matter, in its brief or reply brief at final hearing. Clearly, this

Interference No. 102,462

panel could not have misapprehended or overlooked evidence and/or arguments which were not before it at final hearing. See Keebler Co. v. Murray Bakery Prods., 866 F.2d 1386, 1388, 9 USPQ2d 1736, 1738 (Fed. Cir. 1989) ("Prescience is not a required characteristic of the board.").

Point (5)

Maeda further requests that this panel reconsider its decision affirming the APJ's denial of Maeda's motion under 37 CFR § 1.633(a) for judgment on the ground that Tallon's claims 117-119 and 121 are not patentable to Tallon. See Request for Reconsideration, pp. 16-20. Maeda's arguments focus on this panel's finding that "Maeda has failed to point to any evidence in the record which establishes that the 2223 compound claimed by Tallon is inherently contained in the disclosed Bi-Sr-Ca-Cu-O systems." Final decision, p. 25.

However, in its request for reconsideration, Maeda failed to identify any points misapprehended or overlooked by this panel in rendering its final decision. Rather, Maeda's arguments are merely a rehash of the arguments presented in its brief and reply brief at final hearing.¹⁴ See Final decision, pp. 21-28. As

¹⁴As pointed out in the final decision and in Tallon's

(continued...)

Interference No. 102,462

pointed out above, a disagreement with the panel's decision is not a proper matter for reconsideration under 37 CFR § 1.658.

Point (2)

Finally, this panel dismissed the "Notice under 37 CFR §§ 1.642/1.655" for failure to comply with 37 CFR § 1.645(b). See Final Decision, pp. 28-29. The purpose of filing the paper was "to bring a U.S. patent to Eibl, no. 5,665,662, issued September 9, 1997, to the attention of the Patent and Trademark Office." See Paper No. 327.

There is no dispute that the parties failed to comply with 37 CFR § 1.645(b). See Maeda Request, p. 7. Rather, in its request for reconsideration, Maeda elaborates on the relevance of the Eibl patent and argues that this panel should have exercised its discretion under 37 CFR § 1.641(a) and/or § 1.655(c) at final hearing and considered the Eibl patent. Manifestly, Maeda has failed to show how this panel's decision not to exercise its

¹⁴(...continued)

opposition to Maeda's request for reconsideration, the Takayama-Muromachi article, the Tarascon articles, the Ikeda article and the Zandbergen article (Maeda Record, pp. 96-98, 91-95, 99-106, 122-125 and 126-132, respectively) are not prior art to Tallon under 35 U.S.C. § 102(a). See Final decision, pp. 26-27; Tallon's response, p. 14. Additionally, the Hazen book was published in 1989, and therefore, is not prior art to Tallon under 35 U.S.C. § 102(a). See Index of Maeda Record, p. ii.

Interference No. 102,462

discretion under 37 CFR § 1.641(a) or § 1.655(c) amounts to a point which has been "misapprehended or overlooked" under 37 CFR § 1.658(b). See Tallon's opposition, pp. 8-9.

Conclusion

Maeda's request for reconsideration is granted to the extent that this panel considered Maeda's motion to deny Tallon benefit of its first-filed New Zealand application and the accompanying motion under 37 CFR § 1.645(b). For the reasons set forth above, Maeda's motion under 37 CFR § 1.645(b) is granted-in-part, and Maeda's motion to deny Tallon benefit of its first-filed New Zealand application is dismissed-in-part and denied-in-part.

Interference No. 102,462

Accordingly, it is not necessary for this panel to modify its
DECISION UNDER 37 CFR § 1.658 mailed March 29, 2001.

GRANTED-IN-PART

MARC L. CAROFF)	
Administrative Patent Judge)	
)	
)	
WILLIAM F. PATE, II)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
ADRIENE LEPIANE HANLON)	
Administrative Patent Judge)	

ALH:svt

Interference No. 102,462

Attorneys for Tallon et al.:

Sam Pasternack, Esq.
CHOATE, HALL & STEWART
Exchange Place
53 State Street
Boston, MA 02109

Attorneys for Chu:

Charles M. Cox, Esq.
AKIN, GUMP, STRAUSS,
HAUER & FELD, LLP
711 Louisiana
Suite 1900
Houston, TX 77002

Attorneys for Kugimiya et al.:

Paul F. Prestia, Esq.
One Westlakes, Berwyn
P.O. Box 980
Suite 301
Valley Forge, PA 19482-0980

Attorneys for Von Schnering et al.:

Rudolf E. Hutz, Esq.
CONNOLLY & HUTZ
1220 Market Building
P.O. Box 2207
Wilmington, DE 19899

Attorneys for Gopalakrishnan et al.:

Gerald E. Deitch, Esq.
DuPont Legal
BMP 17/2120
P.O. Box 80017
Wilmington, DE 19880-0017

Interference No. 102,462

Attorneys for Maeda et al.:

Matthew Jacob, Esq.
WENDEROTH, LIND & PONACK, LLP
2033 K Street, N.W.
Suite 800
Washington, D.C. 20006